

REMARKS

The Official Action mailed February 4, 2010, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on September 27, 2006, and January 15, 2009.

A further Information Disclosure Statement was filed on February 12, 2010, and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-19 were pending in the present application prior to the above amendment. Claims 9 and 13 have been amended to correct minor informalities, and new dependent claims 20-22 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 1-22 are now pending in the present application, of which claims 1, 6, 9, 10 and 13 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1-19 under 35 U.S.C. § 112, first paragraph, asserting that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" (page 2, Paper No. 20100121). Specifically, the Official Action asserts that "[t]he claim limitation of 'a second resonance circuit' was not disclosed in the original disclosure" (*Id.*). The Applicant respectfully disagrees and traverses the above assertion in the Official Action.

Claim 1 recites the following (with examples of support): a product management system (e.g. Embodiment 2, paragraphs [0075]-[0081] of the pre-grant publication, i.e. U.S. Publication No. 2008/0224831, Figure 4) comprising: a first resonance circuit (e.g.

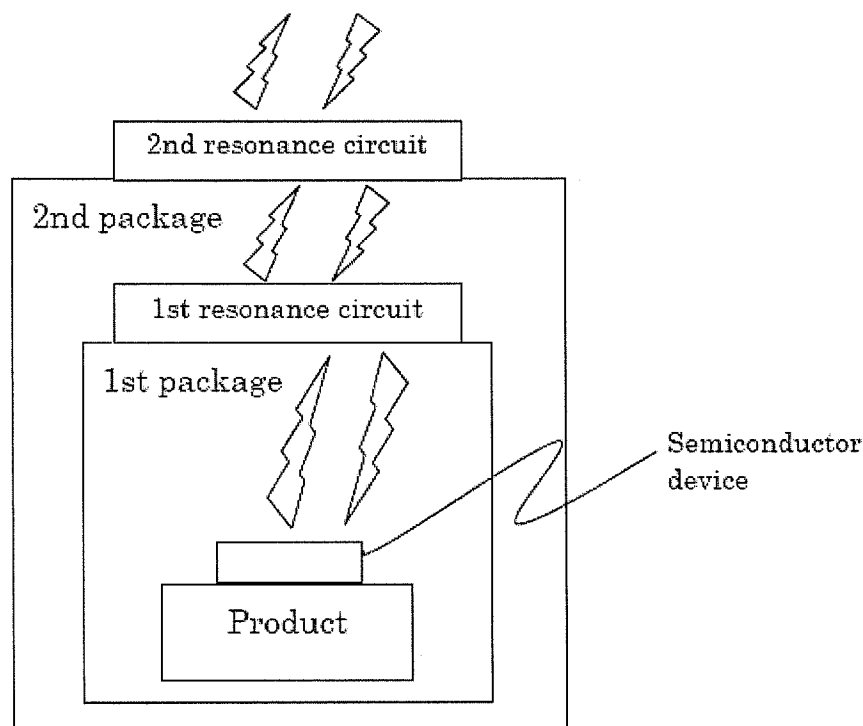
Figure 4, 4); a second resonance circuit (e.g. Figure 4, 39); and a reader/writer (e.g. Figure 4, 5) for at least one of reading information stored in a semiconductor device (e.g. Figure 4, 2) and writing information in the semiconductor device, wherein the first resonance circuit comprises a first antenna coil (e.g. Figure 2, 18) and a first capacitor (e.g. Figure 2, 19) (see also paragraph [0077], which refers to Figure 2, Embodiment Mode 2), wherein the second resonance circuit comprises a second antenna coil and a second capacitor (see also paragraph [0077]), herein a first packing material (e.g. Figure 4, 3) for packing a product (e.g. Figure 4, 1) is provided with the first resonance circuit, wherein a second packing material (e.g. Figure 4, 38) for packing the first packing material is provided with the second resonance circuit, wherein the product is provided with the semiconductor device, wherein the second resonance circuit can communicate with the reader/writer and the first resonance circuit (e.g. paragraph [0078]), and wherein the first resonance circuit can communicate with the second resonance circuit and the semiconductor device (e.g. paragraph [0078]). Claim 2 recites the following (with examples of support): wherein a communication method between the reader/writer and the first resonance circuit, a communication method between the first resonance circuit and the second resonance circuit, and a communication method between the second resonance circuit and the semiconductor device are identical to each other (e.g. paragraph [0078]).

Therefore, the Applicant respectfully submits that claims 1 and 2 are described in the specification in such a way as to reasonably convey to one skilled in the art that the present inventors, at the time the application was filed, had possession of the claimed invention. Independent claims 6 and 9 include similar recitations as compared to claims 1 and 2 and are similarly supported in the present specification. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 1-5, 7 and 8 as anticipated by U.S. Patent No. 6,563,425 to Nicholson. The Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Specifically, claim 1 recites "a first resonance circuit," "a second resonance circuit," "a reader/writer" and "a semiconductor device," "a first packing material for packing a product" and "a second packing material for packing the first packing material," where "the first resonance circuit can communicate with the second resonance circuit and the semiconductor device." That is, the product is provided with the semiconductor device, the first packing material is provided with the first resonance circuit, and the second packing material is provided with the second resonance circuit, as shown, for example, below.



For the reasons provided below, the Applicant respectfully submits that Nicholson does not teach the above-referenced features of the present invention, either explicitly or inherently.

The Official Action asserts that “Nicholson et al. clearly show and discloses a product management system comprising: a first resonance circuit (14, Fig. 8A); a second resonance circuit (passive repeater apparatus) (40, Fig. 8A); and a reader/writer (2, Fig. 1)(Column 3 lines 40-46) for at least one of reading information stored in a semiconductor device (tag)(14, Fig. 8A) ... (Column 3 lines 28-34)” (pages 2-3, Paper No. 20100121; emphasis added). The Official Action further asserts that “a first packing material (49, Fig. 8B) for packing a product is provided with the first resonance circuit (14, Fig. 8B), wherein a second packing material (48b, Fig. 8B) for packing the first packing material is provided with the second resonance circuit (40, Fig. 8A), wherein the product (49, Fig. 8B) is provided with the semiconductor device” (page 3, Id.). The Applicant respectfully disagrees and traverses the assertions of the Official Action.

Initially, it is noted that Nicholson does not disclose, either explicitly or inherently, "a reader/writer 2" in Figure 1. Moreover, the Official Action improperly relies on Nicholson's tag 14 as both the claimed semiconductor device and the claimed first resonance circuit, and on Nicholson's product container 49 as both the claimed product and the claimed first packing material. Product container 49 does not pack product container 49; therefore, it is not reasonable to assert that Nicholson discloses, either inherently or explicitly, a first packing material packing a product. Similarly, tag 14 communicates with tag 14; therefore, it is not reasonable to assert that Nicholson discloses, either explicitly or inherently, a first resonance circuit communicating with a semiconductor device. Therefore, the Applicant respectfully submits that Nicholson does not teach a first packing material for packing a product or that the first resonance circuit can communicate with the second resonance circuit and the semiconductor device, either explicitly or inherently.

Since Nicholson does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 6 of the Official Action rejects claim 6 as obvious based on Nicholson. The Applicant respectfully traverses the rejections because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found

either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Independent claim 6 recites that a first packing material for packing a product is provided with the first resonance circuit and that the first resonance circuit can communicate with the second resonance circuit and the semiconductor device. For the reasons provided below, Nicholson does not teach or suggest the above-referenced features of the present invention.

The Official Action asserts that the claimed communication range is obvious. Please incorporate the arguments above with respect to the deficiencies in Nicholson. The Official Action asserts that "it would have been obvious ... to determine that the extended read/write range as shown in Nicholson et al. is longer than a fixed range between resonance circuit and semiconductor device" (page 6, Paper No. 20100121). However, the Applicant respectfully submits that Nicholson does not teach or suggest a first packing material for packing a product or that the first resonance circuit can communicate with the second resonance circuit and the semiconductor device. Since Nicholson does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Paragraph 7 of the Official Action rejects claims 9-12 and 18 as obvious based on the combination of U.S. Publication No. 2004/0217867 to Bridgelall, U.S. Publication No. 2004/0245519 to Van De Walle and Nicholson. Paragraph 8 of the Official Action rejects claims 13-17 and 19 as obvious based on the combination of Nicholson and Van

De Walle. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

There is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Bridgelall, Van De Walle and Nicholson or Nicholson and Van De Walle or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

With respect to claims 9 and 12, the Official Action asserts that "it would have been obvious ... to include the semiconductor device comprises a thin film integrated circuit comprising a thin film, an antenna, and a capacitor as shown in Van De Walle et al., and the semiconductor device is attached to a product, the product is contained in a packing material, the resonance circuit is attached to the packing material and the reader/writer is disposed outside of the packing material as shown in Nicholson et al., in Bridgelall et al. method for the benefit of providing micro contact printing to reduce the manufacturing cost of RFID tag and extending the read/write range of the designated tag" (page 7, Paper No. 20100121). The Applicant respectfully disagrees and traverses the above assertions in the Official Action.

The Applicant respectfully submits that Bridgelall and Van De Walle do not cure the above-referenced deficiencies in Nicholson. The Official Action relies on Bridgelall to allegedly teach RFID relay devices 23 and 35, each of which is attached to containers 40, which are stacked. The RFID relay devices are used for relaying the signals to another RFID relay device. On the other hand, Nicholson discloses that

container 48 has a passive repeater apparatus 40, containing boxes 46 or product containers 49. Each of the boxes or the product containers has a tag 14. Further, the passive repeater apparatus 40 can communicate with the tags 14. Since the transmitting method of the signals are different from each other, it is respectfully submitted that one of ordinary skill in the art at the time of the present invention would not have had sufficient reasons from the teachings of the prior art to substitute one of the relay devices of Bridgelall for the container 48 or the like of Nicholson.

With respect to claim 10, the asserted references do not teach or suggest the claimed first packing material provided with the first resonance circuit, which packs the product provided with the semiconductor device, or the claimed second packing material provided with the second resonance circuit, which packs the first packing material (discussed above).

With respect to claim 13, the Official Action asserts that "it would have been obvious ... to include the semiconductor device comprises a thin film integrated circuit comprising a thin film transistor, and an antenna as shown in Van De Walle et al., in Nicholson et al. device for the benefit of providing micro contact printing to reduce the manufacturing cost of RFID tag" (page 12, Paper No. 20100121). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

The Official Action relies on Van De Walle to allegedly teach the thin film integrated circuit. However, the thin film transistor of Van De Walle is used as a transponder. One of ordinary skill in the art at the time of the present invention would not have had sufficient reasons from the teachings of the prior art to combine the transponder of Van De Walle with the passive repeater apparatus 40 of Nicholson.

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Bridgelall, Van De Walle and Nicholson or Nicholson and Van De Walle or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Furthermore, with respect to independent claims 1, 6, 9, 10 and 13, please incorporate the arguments above with respect to the deficiencies in Nicholson. Bridgelall and Van De Walle do not cure the deficiencies in Nicholson. The Official Action relies on Bridgelall and Van De Walle to allegedly teach the features noted above. However, Bridgelall, Van De Walle and Nicholson, either alone or in combination, do not teach or suggest that is reasonable to rely on Nicholson's tag 14 as both the claimed semiconductor device and the claimed first resonance circuit, or that it is reasonable to rely on Nicholson's product container 49 as both the claimed product and the claimed first packing material. Therefore, Bridgelall, Van De Walle and Nicholson, either alone or in combination, do not teach or suggest a first packing material for packing a product or that the first resonance circuit can communicate with the second resonance circuit and the semiconductor device. Since Bridgelall, Van De Walle and Nicholson do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 20-22 have been added to recite additional protection to which the Applicant is entitled. For the reasons stated above and already of record the Applicant respectfully submits that new claims 20-22 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,



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